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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,884	11/13/2001	Hiroynki Onishi	U 013711-6	5111
140	7590	09/09/2004	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			FLETCHER III, WILLIAM P	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 09/09/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/009,884

**Applicant(s)**

ONISHI ET AL.

**Examiner**

William P. Fletcher III

**Art Unit**

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 11-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/11/02 &amp; 2/12/04</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I, claims 1-45, in the reply filed on 6/17/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 46-66 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse (see above).
3. Applicant's election with traverse of a sulfur compound treatment agent species (claims 1-3, and 8-10) in the reply filed on 6/17/2004 is acknowledged. The traversal is on the ground(s) that the species election requirement is premature because the examiner has not informed applicant of "the reasons that the examiner contends that the independent claim to the genus does not avoid the prior art." This is not found persuasive because, in the Office action mailed 5/18/2004, the examiner explicitly stated that the cited JP references *clearly anticipate* independent claim 1; teaching, as particular species, at least fluorine compounds, as well as natural and synthetic resins. Because the generic claim is clearly anticipated by the prior art, and because at least one of the claimed species is clearly anticipated by the prior art, there can be no unity under PCT Rule 13 (and corresponding US practice for 37 CFR 371 applications). Formal grounds of rejection under 35 USC 102 and/or 103 are not required when making an election/restriction requirement (see MPEP 803, 1850).

The requirement is still deemed proper and is therefore made FINAL.

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4. Claims 4-9 and 11-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/17/2004 (see above).

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-3 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shores (US 5,543,171 A).**

Shores teaches a process in which the surface of a substrate, previously printed on with an ink, is subsequently coated with an overprint varnish (9:54-61 and Examples). The OP varnish contains a thio derivative, an example of which is thiourea (3:26-30). The OP varnish also contains resins which read on, at least, synthetic resins (9:25-36). The OP varnish may be applied by immersion, spraying, brushing, and roll coating (9:37-43).

7. **Claims 1, 2, 9, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 07-041726 A.**

This reference teaches a process in which an ink-printed layer is coated with a protective overprint varnish that contains polyvinyl alcohol resin (abstract and “Means for Solving the Problem”).

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8. **Claims 1, 2, and 8-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 09-048180 A).**

This reference teaches a process in which an ink-printed layer is coated with a protective coating composition that contains a variety of synthetic resins and resin mixtures (abstract and “Means for Solving Problem”).

9. **Claims 1, 2, and 8-10 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by JP 11-279440 A).**

This reference teaches a process in which an in-printed layer is coated with an overprint varnish that contains a variety of resins, including a fluorinated resin (abstract and “Means for Solving Problem”).

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Fletcher III whose telephone number is (571) 272-1419. The examiner can normally be reached on Monday through Friday, 9 AM to 5 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Shrive P. Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*WPF 9/3/2004*

William P. Fletcher III  
Examiner  
Art Unit 1762

  
SHIVE P. BECK  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1762